

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Art Unit: 3622

Levy et al

Confirmation No.: 2711

Application No.: 10/028,751

Filed: December 21, 2001

For: WATERMARK AND FINGERPRINT
SYSTEMS FOR MEDIA (as amended)

VIA ELECTRONIC FILING

Examiner: Brown, Alvin L

Date: February 10, 2009

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants request review of the final rejection of claims 5-7, 9-12 and 22-25 in the above-identified application. No amendment is being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets. (No more than 5 pages are provided.)

Date: February 10, 2009

Respectfully submitted,
DIGIMARC CORPORATION

Customer Number 23735

Telephone: 503-469-4800
FAX: 503-469-4777

By /William Y. Conwell/
William Y. Conwell
Registration No. 31,943
Attorney of Record

PRE-APPEAL BRIEF REQUEST FOR REVIEW

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Board will reverse the rejections. A few reasons for reversal are noted below.

Claims 5, 7, 10-12 and 22-24 stand rejected as anticipated by Abecassis (6,553,178).

Claim 5 concerns an arrangement for sensing – by fingerprint or watermark data – whether a user has played a promotional message (e.g., advertisement) within video content. If the fingerprint/watermark is not sensed, this indicates the user has skipped over the advertisement (e.g., by fast-forwarding), to more rapidly reach a second portion of the video. If there is failed sensing of the fingerprint/watermark (i.e., the user has skipped through the advertisement), this changes the terms under which the video content is provided to the user.

Abecassis teaches a “skip function” that can be invoked by a user to skip to a next segment of the video. By such arrangement, a viewer can skip scenes of a movie that might be distressing to a child (col. 40, ll. 15-16) or skip the views of a particular panelist in a panel discussion (col. 39, ll. 59-63). The user of Abecassis can choose to view promotional videos (e.g., for Coke or Nike) to receive credit. These credits may reduce the user’s monthly video bill.

Thus, Abecassis may be used to incent viewing of promotional messages. However, it does so in a manner different than presently claimed.

In particular, claim 5 requires “*sensing the fingerprint or watermark of the promotional message when the promotional message is rendered...*” Abecassis does not do this. As such, it cannot anticipate.

Similarly, independent claim 7 requires “*...wherein sensing of one or more of said fingerprinted or watermarked messages entitles a user to access other content or capabilities as a reward...*” Lacking any disclosure of fingerprinted or watermarked promotional messages, Abecassis cannot anticipate.

Independent claim 10 concerns an arrangement in which promotional content is *not* inserted as an interruption between two portions of video (as is the case with traditional advertising), but rather relates to video content that includes promotional content *integrated therein*.

See, in connection with this language, the corresponding disclosure of applicants' specification at page 7, lines 6-18:

Connected Content and Advertising

Another concept is to include connected-ads within (as opposed to interrupting) the entertainment. If someone "clicks" on (or during) the ad, or otherwise activates same, then they receive money towards watching the TV show. If someone doesn't want to click on the ad, they pay for the show. The ads are linked to information via watermarks.

For example, if Ross in the TV show Friends is drinking a Coke during the show, then clicking during that time will present the viewer with linking options, one of which is viewing the web page of Coke. It will be identified that this is an advertising link, possibly with an ad credit symbol such as a \$. If the user clicks on this option, they will receive some benefit, such as x cents deducted from their monthly TV bill. Thus, if they want to watch TV without ads, they just don't click on ads and pay more for the monthly TV bill.

Claim 10 requires "*receiving a signal from a user interaction device indicating selection of the promotional content during the rendering of said video entertainment content.*" (E.g., the user clicks on a can of Coke shown in the sitcom scene.)

The Final Rejection cites Abecassis at col. 45, lines 10-18 as teaching the italicized claim language. However, it does not so teach. Rather, the cited passage states:

When the viewer selected video is an advertisement, ¹⁰
video server software credits a viewer's viewing of an
advertisement towards the charges incurred by the viewer in
the selection of other video services for which the viewer
may incur a charge. By subsidizing a viewer's utilization of
other video services with a credit received for the viewing of ¹⁵
a selected advertisement, the viewer receives compensation
independently of the purchase of the advertised product or
service.

It will be recognized that this passage from Abecassis relates to user selection – for viewing – of a traditional *advertisement*. It does not teach selecting promotional content

integrated within the entertainment content. Nor does it teach selection of such integrated promotional content “*during the rendering*” of the video entertainment content.

Again, because the art does not teach that for which it has been cited, the Board will reverse.

Claims 11, 12 and 22-24 are also rejected as anticipated by Abecassis. But each depends from claim 10. Since claim 10 is not anticipated, neither can claims 11, 12 and 22-24 be anticipated.

The remaining claims are rejected as obvious over Abecassis in combination with other art. However, such rejections also fail due to the above-noted shortcomings of Abecassis. Accordingly, *prima facie* obviousness has not been established.

These remarks have particularly addressed only certain of the claims, and have detailed only certain of the errors in the Final Rejection. However, such discussion is believed sufficient to show that the Final Rejection is ill-founded in several respects, and that the Board will reverse.